

EMAIL CORRESPONDENCE BETWEEN  
SENIOR LEGAL ADVISOR EUGENIA JONES,  
COUNSEL'S ASSISTANT CHRISTOPHER SOREY,  
AND APPLICANT'S COUNSEL

From: Jones, Eugenia [Eugenia.Jones@USPTO.GOV]  
Sent: Tuesday, September 06, 2005 4:58 PM  
To: Linda Shapiro  
Cc: Christopher L. Sorey; Ferriter, Karin  
Subject: RE: Question Regarding Declarations

Ms. Shapiro,

We do not think that anything further needs to be done to correct the misspelling that you have indicated. The filing receipt is correct.

Gena Jones  
Senior Legal Advisor  
Office of Patent Legal Administration  
Madison West, 7C85  
(571) 272-7727

-----Original Message-----

From: Linda Shapiro [mailto:ls Shapiro@jhip.com]  
Sent: Friday, September 02, 2005 8:27 AM  
To: Jones, Eugenia  
Cc: Christopher L. Sorey  
Subject: RE: Question Regarding Declarations

PRIVILEGED AND CONFIDENTIAL

September 2, 2005

Ms. Jones,

Thank you for your reply to Mr. Sorey. As he is out of the office today, I would like to clarify the issue here. In the executed declaration, the date in the claim to foreign priority was correct, but there was a typographical error in the spelling of the month -- "February" was spelled "Febuary." The Official Filing Receipt correctly reflects the filing date of the priority application.

I find it difficult to believe that a typographical error in the spelling of the month of a priority application filing date would necessitate the filing of a supplemental declaration, but I can't find any guidance on this in the MPEP. I gather that we could file a supplemental data sheet, although even this seems to be uncalled for.

Any further guidance you can provide would be appreciated.

Linda Shapiro, Reg. No. 28,264  
Senior Attorney  
Jacobson Holman PLLC  
400 Seventh Street, N.W.  
Washington, D.C. 20004  
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Confidentiality Notice  
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Tel: 202-638-6666  
Fax: 202-393-5350

-----Original Message-----

From: Jones, Eugenia [mailto:Eugenia.Jones@USPTO.GOV]  
Sent: Thursday, September 01, 2005 6:25 PM  
To: csorey@jhip.com  
Cc: Spar, Bob  
Subject: FW: Question Regarding Declarations

Mr. Sorey,

I am not sure what you mean when you say there was a "misspelled issue/publication date for a disclosed foreign priority reference." Under 37 CFR 1.55, a claim for foreign priority must identify the foreign application for which priority is claimed by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. If the filing date of the foreign application that was provided in the claim for foreign priority was incorrect, it may be corrected by filing either an application data sheet or a newly executed declaration, BUT, if it is more than four months from the filing date of the application claiming priority or sixteen months from the filing date of the foreign application, a petition to accept an unintentionally delayed claim under 37 CFR 1.55(c) (which requires payment of the surcharge as set forth in 37 CFR 1.17(t)) is also required. See 37 CFR 1.55(a) and (c) and 1.63(c).

Please let me know if you have further questions. Thanks.

Gena Jones  
Senior Legal Advisor  
Office of Patent Legal Administration  
Madison West, 7C85  
(571) 272-7727

-----Original Message-----

From: Spar, Bob  
Sent: Thursday, September 01, 2005 5:03 PM  
To: Jones, Eugenia  
Subject: FW: Question Regarding Declarations

Please respond to the below query.

Bob Spar  
Director, Office of Patent Legal Administration  
Madison West 7D89  
Office of Deputy Commissioner for Patent Examination Policy  
(571) 272-7700      bob.spar@uspto.gov

-----Original Message-----

From: Christopher L. Sorey [mailto:csorey@jhip.com]  
Sent: Thursday, September 01, 2005 2:43 PM  
To: Spar, Bob  
Cc: lshapiro@jhip.com  
Subject: Question Regarding Declarations

Mr. Spar,

You were recommended to me by a colleague for your expertise in the nuances of the MPEP.

We recently received notice from an Examiner that our client's Declaration was defective because of a misspelled issue/publication date for a disclosed foreign priority reference. Now, we did not file an Application Data Sheet with the Declaration. So, my question is essentially, whether filing a subsequent Application Data Sheet is the only remedy aside from refiling a newly executed Declaration.

Thank you in advance for your attention to this matter. Should you require additional information or have further questions, please feel free to contact me.

Chris Sorey  
Jacobson Holman PLLC  
400 Seventh Street, NW  
Washington, DC 20004

202.638.2264

LINDA J. SHAPIRO  
LSHAPIRO@JHIP.COM

September 20, 2005

Dipl.-Ing. Rainer Wunderlich  
WEBER & HEIM  
Irmgarstraße 3  
München, 81479  
GERMANY

PRIVILEGED AND CONFIDENTIAL  
Attorney-Client Communication

Re: U.S. appl. No. 10/786,600; filed February 26, 2004  
For: METHOD AND DEVICE FOR MAKING A FOUNDATION MEMBER  
Inventor(s): Erwin STOTZER  
Your Ref: B 1268/Wu rru  
Our Ref: 00407/P69477US0

Dear Rainer:

In accordance with our recent correspondence, we have finalized and filed a Response at the U.S. Patent and Trademark Office, along with a Petition for a One-Month Extension of Time. We enclose two copies of the Response and Petition as filed, along with our invoice.

We ask you to review the enclosed Response. If any changes appear to be necessary, please contact us immediately, so that we can attempt to submit a Supplemental Response before the Examiner acts on the case. We note that, due to recent changes in the U.S. PTO rules effective October 21, 2004, Supplemental Responses will no longer be entered as a matter of right. A Supplemental Response may be entered if it is clearly limited to:

- (A) Cancellation of a claim(s);
- (B) Adoption of the examiner suggestion(s);
- (C) Placement of the application in condition for allowance;
- (D) Reply to an Office requirement made after the first reply was filed;
- (E) Correction of informalities (e.g., typographical errors); or
- (F) Simplification of issues for appeal.

Please carefully review the enclosed Information Disclosure Statement (IDS) Summary regarding the duty of disclosure rules and timely send us any prior art that is material to patentability.

Dipl.-Ing. Rainer Wunderlich  
September 20, 2005  
Page 2

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Attorney-Client Communication

If you have any questions or comments, please contact us.

Linda J. Shapiro  
for Jacobson Holman, PLLC

LJS/ljs

Enclosures:    Response and attachments  
                  Petition For Extension Of Time  
                  Information Disclosure Statement (IDS) Summary  
                  Invoice